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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/747,982	12/27/2000	Yoriko Azuma	0033-0684P	3639
7590	02/28/2005		EXAMINER	
BIRCH, STEWART, KOLASCH & BIRCH, LLP P.O. Box 747 Falls Church, VA 22040-0747			DURAN, ARTHUR D	
			ART UNIT	PAPER NUMBER
			3622	

DATE MAILED: 02/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.	Applicant(s)	
09/747,982	AZUMA, YORIKO	
Examiner	Art Unit	
Arthur Duran	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

1) Responsive to communication(s) filed on 28 January 2005.  
 2a) This action is FINAL.                            2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

4) Claim(s) 1,4,5 and 8-21 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1,4,5 and 8-21 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
     Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
     Paper No(s)/Mail Date. \_\_\_\_\_

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_\_

## **DETAILED ACTION**

1. Claims 1, 4, 5, 8-21 have been examined.

### ***Response to Amendment***

2. The Amendment filed on 1/28/05 is sufficient to overcome the Goldhaber reference.

### ***Continued Examination Under 37 CFR 1.114***

3. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/28/05 has been entered.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 4, 5, 8-10, 12-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldhaber (5,794,210) in view of Reilly (5,740,549).

Claims 1, 4, 5, 8-9, 16: Goldhaber et al teaches an electronic advertisement receiving apparatus comprising electronic advertisement receiving means (col. 5, lines 50-55, col. 9, lines 60-67); presenting means for presenting the advertisement (col. 9, lines 40-50, fig. 11); and presentation informing means for informing the advertiser of presentation information (col. 7, lines 55-67, col. 17, lines 30-40). Goldhaber also teaches uniquely identifying the advertisement and storage control means for storing the advertisement if it does not match an ad that is already stored (col. 16, lines 25-40); including benefit information from the advertiser to the user in return for presentation of the advertisement (col. 5, lines 25-45); the benefits are updated according to the number of times the advertisement is presented (one time, for example, col. 17, lines 45-55); procedure information representing a procedure for generating presentation information while updating benefits and advertisement receiving apparatus comprises presentation information generating means (col. 7, lines 45-65); validity confirming means for confirming validity of the presentation information (col. 16, lines 10-15, lines 40-65, col. 17, lines 35-60); analyzed electronic advertisement supply means for analyzing for the user advertisements information and supplying advertisement information having contents reflecting the analysis (profile information, col. 18, lines 55-60).

Additionally, Goldhaber further discloses that advertising information has unique identifiers via indexes (Fig. 15, item 466; Fig. 11a, item 182) and that content is uniquely identified via indexes on the user's computer (col 8, lines 40-50).

Goldhaber further discloses that advertising information is saved to the user computer (col 24, lines 45-50)

Goldhaber discloses that only nonduplicate advertisement information is saved on the user computer (Fig. 15; col 20, lines 10-26; col 14, lines 59-67).

Note that the offers to sell something cited (col 20, lines 10-26) above are functionally equivalent to an advertisement and also that Goldhaber discloses presenting advertising (col 1, lines 15-30).

Furthermore, in the above citation (col 16, lines 24-41), note that Goldhaber tracks what advertisement the user views, that advertisements are stored on the user's computer (advertisement receiving apparatus) when the user decides to view an ad, and that only ads that the user has not already viewed are presented to the user as possible ads for viewing. Hence, Goldhaber compares advertisement identifying information to ensure that no duplicate ads are saved to the user's computer.

Goldhaber further discloses that said benefits are updated according the number of times or a time period said advertisement information is presented (col 30, lines 4-8).

Additionally, Reilly further discloses electronic advertisement storage control means for storing said electronic advertisement received by said electronic advertisement receiving means, when said identifying information does not match said identifying information of each of said at least one electronic advertisement stored in said electronic advertisement storing means; and Reilly stores only those identifying information that does not match identifying information that has previously been stored; and Reilly does not store again if ad has been previously stored (col 12, lines 15-20; col 15, line 55-col 16, line 20; Fig. 8; Fig. 12).

Also, Reilly discloses that downloading advertisements can take a long time (col 8, lines 53-59).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Reilly's non-duplicate local storing of advertisements that the user has not yet viewed to Goldhaber's presenting of advertisements for user viewing. One would have been motivated to do this in order to provide ready access to advertisements without wasting storage space.

Goldhaber further discloses that said benefits are updated according to the number of times said advertisement information is presented (col 11, lines 43-55; Fig. 7, item 125 and item 126; Fig. 12).

Goldhaber further discloses the utilization of computers, networks, interfaces, and server (Fig. 1).

Claims 10, 12-15: Goldhaber and Reilly substantially teaches the invention as discussed above.

Goldhaber further discloses response data representing reception of the advertisement (col 5, line 64-col 6, line 3; col 11, lines 32-44; col 16, lines 7-17; col 23, lines 1-5).

Goldhaber further discloses that advertising information has unique identifiers via indexes (Fig. 15, item 466; Fig. 11a, item 182) and that content is uniquely identified via indexes on the user's computer (col 8, lines 40-50).

Goldhaber further discloses tracking advertisement utilization and reception (Fig. 15; col 20, lines 10-26; col 14, lines 59-67).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that Goldhaber can utilize index or other advertisement identifiers to

identify advertisement during interactions. One would have been motivated to do this in order to provide a way of tracking advertisements.

Goldhaber further discloses targeting users with content based on geographic areas (col 2, lines 27-35; col 15, lines 15-21) and that user geographic area information is known (col 13, lines 5-11).

5. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Goldhaber (5,794,210) in view of Reilly (5,740,549) and in view of Gerace (5,848,396).

Claim 11: Goldhaber and Reilly substantially teaches the invention as discussed above. Gerace further discloses ended advertising distribution when a calculated number reaches a predetermined number (col 12, lines 38-41; col 15, lines 12-20).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Gerace's control of the number of times an ad is presented to Goldhaber's presenting of ads. One would have been motivated to do this in order to offer auditing information and control on advertising and the costs of advertising.

6. Claims 17-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldhaber (5,794,210) in view of Reilly (5,740,549) in view of Steele (6,564,047) and in view of Rautila (6,524,189).

Goldhaber discloses the apparatus above.

Goldhaber further discloses multiple communications channels and networks (col 1, lines 20-25; col 3, lines 40-50; col 4, lines 13-20).

Goldhaber does not explicitly disclose utilizing a different channel for advertising information than for other communications.

However, Steele discloses that said presentation informing means informs said advertiser of said presentation information through a first communication line different (bluetooth) from a second communication line (cell net) through which said electronic advertisement receiving means receives said electronic advertisement (col 9, lines 34-50). Steele further discloses that said first communication line can be short-haul wireless communication (col 9, lines 34-50). Steele further discloses a user portable electronic apparatus (Fig. 1) and the utilization of the Internet and advertising (col 1, lines 20-25) and rewarding a user for viewing advertising (col 1, lines 25-35; col 4, lines 35-41).

Please note that Rautila defines that, “Bluetooth is a low-cost, short-haul wireless scheme that sends and receives data via cell phone, portable computer, or other device over a 2.4 GHz spread-spectrum technology” (col 5, lines 27-33).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that Steele’s utilizing different communication lines and wireless communications can be added to Goldhaber’s utilization of the Internet and different communications channels. One would have been motivated to do this in order to provide a portability to the user and a better way of interacting or communicating with advertisement providers.

***Response to Arguments***

7. Applicant's arguments with respect to claims 1, 4, 5, 8-21 have been considered but are moot in grounds of the new rejection.

Examiner notes that while specific references were made to the prior art, it is actually also the prior art in its entirety and the combination of the prior art in its entirety that is being referred to.

Examiner further notes that it is the Applicant's claims as stated in the Applicant's claims that are being rejected with the prior art.

***Conclusion***

The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

a. Dedrick (5,724,521) discloses compensating a user for viewing advertising and regional distribution of advertising.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur Duran whose telephone number is (571) 272-6718. The examiner can normally be reached on Mon- Fri, 8:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Arthur Duran  
Patent Examiner  
2/9/05